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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,187	11/10/2003	Edward E. Elson	482-26-001	4640

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KOPPEL, JACOBS, PATRICK & HEYBL  
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THOUSAND OAKS, CA 91360

EXAMINER

HILL, LAURA C

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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Commissioner for Patents

**Office Action Summary**

Application No.

10/705,187

Applicant(s)

ELSON ET AL.

Examiner

Laura C. Hill

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Election/Restrictions***

- I. Claims 1-21, drawn to a penis sheath, classified in class 604, subclass 351.
- II. Claims 22-25, drawn to method of applying a urine collection sheath, classified in class 604, subclass 351.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process such as providing a cylindrical sheath, placing the penis in the sheath, wrapping securement tape around the sheath, and then grasping both pieces of barrier material so the gel strip contacts and adheres to the penis.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael Ram on 7 July 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 22-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 5, paragraph 0012, line 2, the word 'to' should read 'too'.

Appropriate correction is required.

2. The disclosure is also objected to because of the following informalities: the 'proximal opening 9' on page 11 of the specification is referred to as 'a first end opening' in claim 1, line 5.

Appropriate correction is required.

3. The disclosure is also objected to because of the following informalities: the 'release liner film right half 23 and left half 24' on page 12, paragraph 0067, lines 5-6 is referred to as the 'removable barrier material' in claim 1, line 12.

Appropriate correction is required.

4. The use of the trademark VELCRO on page 30, lines 8-9 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Male Urinary Incontinence Sheath Having Gel Adhesive and Elastic Securement Tape.

#### ***Claim Interpretation***

6. The 'polymeric gel strip' and 'elastic securement tape' of claim 1 are interpreted to form the securement means but the 'gel strip' does not have to be located on the interior and exterior surfaces simultaneously. Likewise, the 'elastic securement tape' does not expressly disclose not have to be located on the interior and exterior surfaces simultaneously.

7. The 'elastic securement tape' and 'polymeric gel' of claim 1 do not have to engage one another so long as the 'elastic securement tape' engages and adheres to any portion of the sheath.

8. The 'first end opening sized to receive at least a portion of the length of a penis' of claim 1, line 5 is interpreted to include any end of the attachment device having an opening or aperture located on the exterior or interior surface of the sheath for receiving any portion of the penis while in use.

9. The 'second end spaced from said first end including a hollow connector sealed therein' of claim 1, lines 6-7 is interpreted to include any area spaced in any fashion

from the first end area and therefore the second end is not necessarily limited to being located directly opposite across from the first end.

10. The 'hollow connector' and 'second hollow connector' of claim 1, line 7 are interpreted to be located within the second end area in any arrangement or configuration as long as they mate with each other.

11. The 'glans of the penis' of claim 1, line 9 is given its broadest reasonable definition of 'the tip or end portion of a penis' (Wikipedia online dictionary).

12. The 'opening' of claim 1, line 12 is interpreted to be either the 'first end opening 9' previously recited in claim 1 or any other type of opening located on or within the device.

13. The 'adjustable straps also passing through slots in a ring encircling the base of the penis' in claim 2 is interpreted to include a device with more than one strap being placed adjacent to or passing entirely through an opening/slot in any type of ring or flange member that encircles the base of any part of the penis.

14. The 'outwardly tapering tangs' of claim 5, line 3 is given its broadest reasonable interpretation of 'a projecting shank, prong' (Merriam-Webster online dictionary) or any other outwardly jutting surface area.

15. The 'urine collection means' of claim 5, line 6 is interpreted to be the top or bottom portion of the device that receives the penis and does not necessarily have to be the same urine 'collection chamber' as recited by the limitation of claim 1.

16. The 'lumen' of claim 10 is given its broadest reasonable interpretation of a 'the bore of a tube' (Merriam-Webster online dictionary).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**17.** Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the 'sheath having an upper surface with an opening' on line 12 does not enable since the upper surface and the opening are not described in the specification or shown in the drawings.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 1-2, 4-10, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim (US 3,788,324) in view of Alexander et al. (US 4,378,018), and further in view of Rogers et al. (US 3,835,857). Regarding claim 1 Lim discloses an external catheter device for attachment to the male member/penis 12 and delivering urine to a remote collection pouch 18 comprising a urine impermeable rubber or plastic, cylindrical sheath 10 (col. 3, ll. 22-34); the cylindrical sheath 10 having an inner and outer surface (figure 3) and having:

An orifice/first end opening 16 on first distal end 14 sized to receive at least a portion of the penis length and a second end, or area opposite and spaced from the distal end 14, having a nipple connector means/hollow connector 22 sealed therein (col. 3, ll. 31-38, figure 1); the hollow connector 22 configured to mate with drainage tube/second hollow connector that is attached to collection chamber/pouch 18 (col. 3, ll. 31-35); the distance between the first distal end 14 and second end is sufficient enough to enclose at least the penis glans (figure 3); and coating/carry securement means in the form of a polymeric gel foam 24 on the interior surface at the first end and along the entire length of sheath 10 (col. 3, ll. 53-60 and ll. 65-col. 4, line 2); the securement means encircling the penis above/circumferentially around the glans (figures 1 and 3); the securement means comprising a **polymeric gel foam 24** (col. 3, ll. 65-col. 4, line 2); the polymeric gel foam 24 attached to an upper circumferential portion of the inner surface of sheath 10 adjacent the first end opening 14 of sheath 10 (figure 1); the gel comprising polyurethane-a polymeric gel material impervious to urine (col. 3, ll. 59-60); having a skin contact surface which provides adhesion to the skin surface of the male

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member/penis 12 but is removable therefrom, providing comfort and without leaving residue (col. 3, ll. 59-65); the polyurethane foam gel 24 is capable of stretching and contracting after application to the penis since foams have springy, elastic-like structures [*Textile Science*, Hatch, page 379] without compromising its adhesion properties since the coating 24 defines a liquid-tight seal for preventing urine in the dome-shaped distal end 14 from contacting the skin of penis during use (col. 4, ll. 6-10);

Lim *does not expressly disclose* the gel strip contact surface has a removable barrier material or that there is an elastic securement tape.

**Alexander et al.** discloses a male urinary drainage device for attachment to a penis for receiving urine and delivering the urine to a container/collection chamber 25 (col. 4, ll. 51-53, figure 5) comprising a cylindrical urine-impermeable rubber sheath 20 (col. 3, ll. 52-58); and having:

A first end opening to receive a portion of the glans 30 of penis 31 (col. 4, ll. 19-20, figure 3) and a second end spaced from the first end including an annular enlargement/ hollow connector 24 configured to mate with a portion/second hollow connector 23 that is attached to collection chamber 25 (col. 4, ll. 54-63, figure 3); and sealant pad/carry securement means 10 on the exterior surface 10b and interior surface 10a at the first end and encircling the penis above the glans 30 (col. 3, ll. 9-11, figure 2), the securement means 10 is capable of producing a sticking action against dry surfaces by using any suitable pressure-sensitive adhesive coating which is waterproof, non-toxic and non-irritating to prevent leakage and promote sheath removal under conditions of

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normal use (col. 3, ll. 9-35); and **removable protective release strips** located on sealant pad/carry securement means 10 (col. 4, ll. 6-12, figure 8).

Alexander et al. does not expressly disclose the securement means comprises a polymeric gel strip or that there is an elastic securement tape. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the polymeric gel strip of Lim et al. with the removable protective release strips of Alexander et al. since both references disclose external penis sheaths with carry securement means for leakage prevention.

**Rogers et al.** discloses a urinal device for attachment to penis 10 for receiving urine and delivering the urine to a fluid container/collection chamber 24 comprising a cylindrical impermeable latex sheath 11 (col. 3, ll. 1-3, 18-31) to ensure urine draining freely when the patient is in a reclining position (col. 3, ll. 50-51) and having:

A first end opening sized to receive a portion of the penis and a second end with hollow connector (elongate intermediate portion including element 21 in figure 1) matingly engaged with second connector/female coupler 22, which is attached to collection chamber 24, the distance between the first and second end being sufficient to enclose the glans (col. 3, ll. 24-31, figure 1), and carry securement means comprising a soft, yieldable liner pad material 28 wrapped around the penile shaft beneath the interior surface/body portion 12 so as to form a liquid-tight cushion and barrier between the sheath 11 and penis 10 (col. 4, ll. 45-49),

The carry securement means also comprising **elastic securement tape 29** having a first end-adheres to and is wrapped around the outside circumferential portion

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of sheath 11 (col. 4, ll. 49-51, figure 1); said elastic securement tape 29 and liner pad 28 result in the sheath being held to the upper portion of the penis in a liquid-tight manner, and thus providing little chance for air to leak/enter between the upper portion of the penis and the upper portion of the sheath (col. 4, ll. 66-col. 5, line 4).

Rogers et al. does not expressly disclose the liner pad/carry securement means comprises a polymeric gel strip or that there is a removable barrier material on the gel strip skin contact surface. Lim, Alexander and Rogers et al. are analogous art because they are in the same field of endeavor; external devices for attachment to the penis for receiving and delivering urine to a collection chamber. Furthermore, Lim, Alexander and Rogers et al. are analogous art because they are in the same problem-solving area—external penis sheaths with carry securement means for leakage prevention. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the polymeric gel strip having removable protective strips of Lim/Alexander with the elastic securement tape of Rogers et al., thus providing the device with carry securement means comprising a polymeric gel strip having a removable barrier covering material and an elastic securement tape since all the references disclose external devices for attachment to the penis for receiving and delivering urine to a collection chamber having carry securement means for leakage prevention.

Regarding claim 2 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Alexander further discloses sealant pad/carry securement means 10 located on sheath 20 including a pair of diametrically opposed slits/slotted tabs 14 for placement of radial straps 12 therethrough, said straps function

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as a sheath retention means and provide a barrier against fluid backup and leakage (col. 3, ll. 36-51), the adjustable radial straps 12 also pass through a central opening located in a ring 13 that encircles the base of the glans penis 30 (figures 1 and 3).

Regarding claim 4 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Rogers et al. further discloses tubular male coupling 22 having an outer diameter on the outer surface of the coupling with a bore/raised boss 43 encircling the hollow connector, the male coupling 22 being sized to be received with the second hollow connector (figure 1).

Regarding claim 5 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Rogers et al. further discloses female member 21 having slots 30 and 31 forming tapering tangs/protruding areas therebetween (col. 5, ll. 33-37 and figure 1), internally concave O-ring/positioning boss 35 which forms a liquid-tight seal (col. 5, ll. 41-42), the second end of the female coupler 21 being attached to a urine collection means [The 'urine collection means' is interpreted to be the top portion of the device that receives the penis and does not necessarily have to be the same urine 'collection chamber' as recited by the limitation of claim 1.] (figure 1).

Regarding claim 6 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Rogers et al. further discloses tubing 23 attached to urine collection chamber 24 and female coupler 21 (col. 6, ll. 4-6, figure 1).

Regarding claim 7 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Rogers et al. further discloses stem

member/sliding locking collar 37 for placement over O-ring/positioning boss 35 on the male coupler 22 and the female coupling 21 after engagement (col. 5, ll. 51-55).

Regarding claim 8 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 1. Rogers et al. further discloses vent nipple/one way flow valve 59 positioned below the second end of sheath 11, the valve 59 would be capable of allowing urine to flow from the sheath to collection chamber 24 but not from the collection chamber 24 to sheath 11 since the valve is not directly connected to sheath 11 (col. 6, ll. 49-50 and 62-67, figure 1). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Regarding claim 9 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 8. Rogers et al. further discloses one-way valve 59 with flaps/leaflet portions 61 so that no liquid can escape through the valve 59 (col. 6, ll. 57-60).

Regarding claim 10 Lim, Alexander et al. and Rogers et al. disclose the device as discussed above with respect to claim 8. Rogers et al. further discloses the vent nipple/one way flow valve 59 positioned within a lumen of the hollow connector [Note that the lumen is considered to be the entire inside bore of tubing 23, including the portion of the tubing that empties out into 24. Therefore the valve 59 is 'positioned within the lumen' since the valve also extends/empties out into 24] (figure 1).

Regarding claim 14 Lim/Alexander et al./Rogers et al. discloses the device for application to a skin surface with removable barrier layer as discussed above with

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respect to claim 1. Lim/Alexander et al./Rogers et al. do not expressly disclose the barrier material has perforations. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the removable barrier layer of Lim/Alexander et al./Rogers et al. to include perforations since the barrier layer disclosed is applied to the surface of the skin.

Regarding claim 15 Lim/Alexander et al./Rogers et al. discloses the device with elastic securement tape as discussed above with respect to claim 1.

Regarding claim 16 Lim/Alexander et al./Rogers et al. discloses the device having carry/multiple retention means comprising a gelatinous material, elastic securement means/tape and strap system as discussed above with respect to claim 1.

Regarding claims 17-21 Lim/Alexander et al./Rogers et al. discloses the device having carry/multiple retention means comprising a gelatinous material, elastic securement means/tape and strap system as discussed above with respect to claims 11-15 and 16.

19. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lim (US 3,788,324) in view of Alexander et al. (US 4,378,018), in view of Rogers et al. (US 3,835,857) as applied to claim 2 above, and further in view of Dwork (US 6,113,582). Lim/Alexander et al./Rogers et al. discloses the device with slotted tabs and adjustable straps as discussed above with respect to claim 2. Rogers et al. discloses the receptacle/collection chamber 24 is designed to be secured to the leg of the user (col. 6, ll. 25-26). Lim/Alexander et al./Rogers et al. do not expressly disclose multiple belts encircling the waist. Dwork discloses a device/retention body 22 for receiving urine and

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delivering the urine to collection chamber 50 (col. 5, ll. 46-53, col. 6, ll. 65-col. 7, line 2, figure 3) with sheath wrap 40 that encloses the penis having a carry securement means comprising an inner adhesive strip and removable backing 46 (col. 6, ll. 31-34). Dwork further discloses belts/bands 28 that pass through slots 30 on retention body/ring 22 encircling the base of the penis (col. 5, ll. 64-67), said bands/belts 28 encircling the waist and thighs of the individual (figures 2-3). Lim, Alexander et al., Rogers et al. and Dwork are analogous art because they are in the same field of endeavor; external devices for attachment to the penis for receiving and delivering urine to a collection chamber. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the devices having retention bands of Lim/Alexander et al./Rogers et al. with the waist band of Dwork since all the references disclose external devices with attachment means for attachment to the penis for receiving and delivering urine to a collection chamber.

20. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable Lim (US 3,788,324) in view of Alexander et al. (US 4,378,018), in view of Rogers et al. (US 3,835,857) as applied to claim 1 above, and further in view of Furuno et al (JP abstract 11323616). Regarding claims 11-12 Lim/Alexander et al./Rogers et al. discloses the device with impermeable polyurethane foam gel strip material that adheres to the user's skin as discussed above with respect to claim 1 that would have a polyurethane structure inherently resistant to erosion when exposed to urine since the device collects urine. Lim/Alexander et al./Rogers et al. do not expressly disclose the polyurethane gel strip is resistant to swelling when being wetted. Furuno discloses an adhesive pad

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capable of holding an adhesive force for a constant period, even when washed with water and adhered to a person using a silicone gel adhesive layer 3 laminated to the adhesive surface of the main body and acting as a double sided adhesive strip (abstract). Furuno does not expressly disclose a device with a sheath that encloses a penis. Furuno is relied upon for its teaching that a silicone gel adhesive is another type of adhesive that can be used for attachment onto the surface of a wearer's skin. Lim, Alexander et al., Rogers et al. and Furuno are analogous art because they are in the same field of endeavor; adhesive articles that attach to the surface of genital parts during use. It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the polymeric adhesive gel strip of Lim, Alexander et al., Rogers et al. with the silicone double-sided adhesive of Furuno since all references disclose polymeric adhesives for attachment to the surface of the genitals.

Regarding claim 13 Lim/Alexander et al./Rogers et al. discloses the device with polyurethane foam gel material 24 that inherently has a modulus of elongation and shear strength (since polyurethane foam gels have bubbles in their structure, which causes expansion of the overall structure) that enables the gel material to expand during normal usage with skin adhesion properties and leakage prevention as discussed above with respect to claim 1. The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not expressly disclose not render the old composition patentably new to the discoverer. *Atlas Powder Co. v. Ireco Inc.*, 190F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown

property which is inherently present in the prior art does not expressly disclose not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

21. Claims 1-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of copending Application No. 10/868289. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ivens et al. (GB 2,126,483A) is cited for showing an impermeable

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rubber penial urine ducting/ sheath 101 with first opening and adhesive tape 113 for encircling the penis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Hill whose telephone number is 571-272-7137. The examiner can normally be reached on Monday through Friday (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura C. Hill  
Examiner  
Art Unit 3761

LCH



**TATYANA ZALUKAEVA**  
**PRIMARY EXAMINER**

